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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,299	12/05/2000	Kenneth H. Falchuk	healre01.012	7848
25247 7590 11/19/2007 GORDON E NELSON PATENT ATTORNEY, PC 57 CENTRAL ST PO BOX 782 ROWLEY, MA 01969			EXAMINER PASS, NATALIE	
			ART UNIT 3626	PAPER NUMBER
			MAIL DATE 11/19/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/730,299	Applicant(s) FALCHUK ET AL.	
	Examiner Natalie A. Pass	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

Notice to Applicant

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2 August 2007 has been entered.
2. This communication is in response to the Request for Continued Examination and amendment filed 2 August 2007. Claims 1-4 have been amended. Claims 1-4 remain pending.

Claim Rejections - 35 USC §101

3. The rejection of claims 1-2 under 35 U.S.C. §101, for being drawn to non-statutory subject matter, is hereby withdrawn due to the amendment filed 2 August 2007.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A) Newly amended claims 1 -4 recite limitations that are new matter, and are therefore rejected. The added material which is not supported by the original disclosure is as follows:

- “certifying that the first physician is entitled to the continuing medical education credit in a database accessible from the intermediary,” as disclosed in claim 1 at lines 19-20;
- “performed in the intermediary under supervision of the medical information specialist” as disclosed in claims 2-4 at lines 2-3, respectively.

35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:

- a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and
- b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

In particular, the Examiner was unable able to find any support for this newly added language within the specification as originally filed on 5 December 2000. Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

Applicant is required to cancel the new matter in the reply to this Office Action.

6. If Applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can, be

amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 5 December 2000.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

NOTE: The following rejections assume that the subject matter added in the 2 August 2007 amendment are NOT new matter, and are provided hereinbelow for Applicant's consideration, on the condition that Applicant properly traverses the new matter objections and rejections made in sections 4-6 above in the next communication sent in response to the present Office Action.

8. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fontelo, P.A. Continuing medical education on the World Wide Web. Military Telemedicine On-Line Today, 1995. 'Research, Practice, and Opportunities', Proceedings of the National Forum 27-29 March 1995. URL:
<<http://ieeexplore.ieee.org/iel3/3745/10944/00504546.pdf?tp=&arnumber=504546&isnumber=10944>>, hereinafter known as Fontelo.

(A) As per newly amended claim 1, Fontelo teaches a method of providing continuing medical education credit to a first physician for a consultation between the first physician and a

second physician, the method comprising the steps performed in an intermediary which is coupled by a telecommunications system to both the first and second physicians of:

arranging and conducting the consultation via the telecommunications system under supervision of a medical information specialist in the intermediary who is neither the first nor the second physician (Fontelo; page 141, column 2, paragraphs 2-3, Figure 1, Figure 5); Examiner interprets the signatures on the last line of the Certificate shown in Figure 5 to be those of the supervising medical information specialists;

receiving a comment made with regard to the consultation via the telecommunications system from the second physician (Fontelo; paragraph bridging page 141 column 2 and page 142, column 1); Examiner interprets Fontelo's teachings of "a forum for exchanging diagnostic opinions on ... [...] ... cases from other pathologists or diagnosticians ... [...] ... " to be a form of "receiving a comment with regard to the consultation via the telecommunications system from the second physician;"

providing the comment to the medical information specialist (Fontelo; paragraph bridging page 141 column 2 and page 142, column 1, page 142, column 2, paragraph 1, Figure 1, Figure 2A, Figure 3), the intermediary being empowered to certify that the first physician is entitled to continuing medical education credit (Fontelo; page 141, column 2, paragraphs 2-3, Figure 1, Figure 5) and the medical information specialist evaluating the consultation represented by the comment to determine whether the first physician is entitled to continuing medical education credit on the basis of the consultation represented by the comment and if the first physician is entitled, certifying that the first physician is entitled to the continuing medical education credit in a database accessible from the intermediary (Fontelo; paragraph bridging

page 141 column 2 and page 142, page 142, column 2, paragraph 1, Figure 1, Figure 2A, Figure 3, Figure 5); Examiner interprets archived images on the server that are “accessible to pathologists worldwide” to be a form of “a database accessible from the intermediary.”

Fontelo fails to explicitly disclose “otherwise not so certifying.” However it is the position of the Examiner that one having ordinary skill in the art at the time of the invention would have found it obvious to include not certifying that the first physician is so entitled within the method disclosed by Fontelo, with the motivation of ensuring that continuing education participation “Guidelines” (Fontelo; Figure 1) are fulfilled prior to awarding CME credits to physicians (Fontelo; paragraph bridging page 141 column 2 and page 142, page 142, page 142, column 2, paragraph 1, Figure 1, Figure 2A, Figure 3).

(B) As per newly amended claim 2, Fontelo teaches a method as analyzed and discussed in claim 1 above wherein the method further comprises the steps performed in the intermediary under supervision of the medical information specialist (Fontelo; Figure 5) of:

retrieving instructional material or information relevant to the comment and the consultation from the data base (Fontelo; page 141, column 2, paragraph 2 to page 142, column 1, paragraph 2); and

providing the instructional material to the first physician via the telecommunications system (Fontelo; page 141, column 2, paragraph 2 to page 142, column 1, paragraph 2).

9. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fontelo, P.A. Continuing Medical Education on the World Wide Web. Military Telemedicine On-Line Today, 1995. 'Research, Practice, and Opportunities.', Proceedings of the National Forum, 27-29 March

1995. URL:

<<http://ieeexplore.ieee.org/iel3/3745/10944/00504546.pdf?tp=&arnumber=504546&isnumber=10944>>, hereinafter known as Fontelo, as applied to claims 1 and 2 above, and further in view of Galewitz, P., Doctors Can Now Get Continuing Education On-Line. Palm Beach Post. Jul 8,

1996. URL:

<<http://proquest.umi.com/pqdweb?did=66323909&sid=4&Fmt=3&clientId=19649&RQT=309&VName=PQD>>, hereinafter known as Galewitz.

(A) As per newly amended claims 3-4, Fontelo teaches a method as analyzed and discussed in claims 1 and 2 above wherein the method further comprises the steps performed in the intermediary under supervision of the medical information specialist (Fontelo; Figure 5).

Fontelo fails to explicitly disclose a method further comprising
providing an examination based on at least the instructional material or the comment via the telecommunications system;
receiving answers for the examination from the first physician via the telecommunications system; and
grading the received answers, the first physician being entitled to the medical education credit if the first physician passes the examination.

However, the above features are well-known in the art, as evidenced by Galewitz.

In particular, Galewitz teaches
providing an examination based on at least the instructional material or the comment via the telecommunications system (Galewitz, page 1, paragraph 5-6);

receiving answers for the examination from the first physician via the telecommunications system (Galewitz, page 1, paragraph 5-6); and

grading the received answers, the first physician being entitled to the medical education credit if the first physician passes the examination (Galewitz, page 1, paragraph 5-6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Fontelo to include these limitations, as taught by Galewitz, with the motivations of placing "having doctors take continuing education tests by computer" and placing "physicians ... [...] ... on the honor system" to ensure they have covered the course materials, and thereby enabling "a doctor ... [to] ... get continuing education credits at his own convenience" (Galewitz, page 1, paragraph 5-8).

Response to Arguments

10. Applicant's arguments on pages 6-7 of the response filed 2 August 2007 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 2 August 2007.

(A) Applicant arguments at pages 6-7 of the response filed 2 August 2007 regarding the Telemedicine and Remote references are moot in view of the new ground(s) of rejection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied articles teach the environment of online continuing medical education courses.

University of Alabama Pediatric Surgery Web Site. November 1996. [Retrieved on November 5, 2007]. Retrieved from Internet. URL:
<<http://web.archive.org/web/19961125115120/http://pedsurg.surgery.uab.edu>>;

CME Gateway. December 1996. [Retrieved on November 5, 2007]. Retrieved from Internet. URL: <<http://web.archive.org/web/19961222183248/http://www.cmegateway.com>>;

Anonymous. Continuing medical education on the Web. Patient Care. Oradell: Feb 15, 1997. Vol. 31, Iss. 3; pg. 43. [Retrieved on November 5, 2007]. URL:
<<http://proquest.umi.com/pqdweb?did=11088353&sid=3&Fmt=2&clientId=19649&RQT=309&VName=PQD>>; and

McEnery, K. W., Computers in Radiologic Education: The Internet, World-Wide Web, and Mosaic: an Overview. American Journal of Roentgenology. 1995. Vol 164, 469-473. [Retrieved on November 5, 2007]. Retrieved from Internet. URL:
<<http://www.ajronline.org/cgi/reprint/164/2/469.pdf>>.

12. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: **(571) 273-8300.**

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Natalie A. Pass

November 6, 2007


C. LUKE GILLIGAN
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600